

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 23

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SYAMAL K. GHOSH,
DILIP K. CHATTERJEE
and THEODORE R. KOLB

Appeal No. 1996-2811
Application 08/402,670¹

ON BRIEF

Before McCANDLISH, Senior Administrative Patent Judge,
FRANKFORT and McQUADE, Administrative Patent Judges.

FRANKFORT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 through 18, all of the claims pending in this application.

¹ Application for patent filed March 13, 1995.

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Appellants' invention relates to a ceramic guide rail for guiding photographic film and paper without adverse effects on said photographic film and paper. Independent claims 1 and 10 are representative of the subject matter on appeal and a copy of those claims can be found in the Appendix to appellants' brief.

The prior art references relied upon by the examiner in rejecting the appealed claims are:

Chatterjee et al. 1994 (Chatterjee '332)	5,290,332	Mar. 1,
Ghosh et al. 1994 (Ghosh '282)	5,336,282	Aug. 9,
Chatterjee et al. 1994 (Chatterjee '913)	5,358,913	Oct. 25,
Yoshida et al. 1990 (Yoshida) (Japanese Patent)	2-187946	Jul. 24,

Claims 1 through 18 stand rejected under 35 U.S.C. § 103 as being unpatentable over Ghosh '282 or Chatterjee '332 or '913 in view of Yoshida.

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Rather than attempt to reiterate the examiner's full commentary with regard to the above-noted rejection and the conflicting viewpoints advanced by the examiner and appellants regarding the rejection, we make reference to the examiner's answer (Paper No. 12, mailed February 22, 1996) for the reasoning in support of the rejection, and to appellants' brief (Paper No. 11, filed January 22, 1996) for the arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by appellants and the examiner. As a consequence of our review, we have made the determinations which follow.

Independent claims 1, 2 and 3 on appeal each define a ceramic guide rail for guiding photographic film and paper. Independent claims 10, 11 and 12 each define a ceramic guide

rail insert bondable to a stainless steel bracket used for guiding photographic film and paper.² As noted on pages 1 and 2 of appellants' specification, prior art guide rails for use in

perforating equipment for photographic film and paper were made of chrome plated stainless steel or hardened stainless steel. However, these guide rails suffered from certain disadvantages, such as a) the edges of the moving film creating a groove in the chrome plated steel rails in a relatively short time and b) the

corrosive silver halide salts in the film attacking the stainless steel rails creating corrosion products, which corrosion products along with the wear debris from the stainless steel rails tended to contaminate the film being perforated. As noted on page 2 of the specification, the present invention replaces the chrome plated stainless steel rails of the prior art with

² In dependent claims 13 through 18, the "ceramic guide rail" set forth in the preamble of each of these claims appears to lack proper antecedent basis. Independent claims 10, 11 and 12 are each directed to a ceramic guide rail insert, not a ceramic guide rail. Likewise, the "guide rail" mentioned in the body of claims 13 through 16 has no proper antecedent basis. The examiner and appellants should correct these defects during any further prosecution of the application.

"yttria tetragonal zirconia polycrystal ceramic rails. The ceramic rails are in many cases more cost effective and provide superior wear resistance and corrosion resistance than prior art chrome plated stainless guide rails. In addition, the absence of corrosion products and the reduction in wear debris helps reduce film contamination."

Appellants and the examiner appear to be in agreement that the applied patents of Ghosh '282 and Chatterjee '332 or '913 disclose the particular ceramic materials described in the present application and set forth in the claims before us on appeal. They are additionally in agreement that these patents do not disclose or teach a guide rail for photographic film and paper wherein the guide rail is formed of the particular zirconium-based ceramic compositions described in those patents. On pages 4 and 5 of the answer, the examiner has taken the position that

"These prior art references do not teach the use of their zirconia compositions for ceramic guide rails. However, it is the examiner's position that it is well known in the art that zirconia has excellent fracture toughness and wear resistant properties and the use of a zirconia composition for a specific application requiring high toughness and wear resistance (e.g. a guide rail) would have been

obvious to one of ordinary skill in the art. Ghosh et al. even teach that their ceramic material has a good resistance to wear (col. 1, first paragraph).

Also, the discovery of a new property or use of a previously known composition, even when that property and use are unobvious from the prior art, can not impart patentability to claims to the known composition. Titanium Metals Corp. v. Banner, 778 F2d 775, 780, 782, 227 USPQ 773, 777-78 (Fed. Cir. 1985). It is therefore the examiner's position that the new use (i.e. guide rail) of a known composition (in this case, admitted by appellants to be known in the art-top of page 4, appellants' specification) can not impart patentability to claims to the known composition."

In addition to the foregoing, the examiner has also noted (answer, page 5) that Yoshida teaches that the use of ceramic materials as guide rails is known in the art, and that since it is well known in the art that zirconium is a ceramic material having properties of excellent wear resistance and toughness, it would have been apparent to one of ordinary skill in the art

"that he or she had the obvious design choice for selecting a specific known ceramic material of high toughness and wear resistance (e.g., a zirconia composition such as those taught by Ghosh et al. and Chatterjee et al.) as a material for a guide rail (in accordance with the teachings of Yoshida)."

Like appellants (brief, pages 4-9), we find the examiner's rejection of claims 1 through 18 on appeal based on Ghosh '282 or Chatterjee '332 or '913 in view of Yoshida to be improper. In the first place, we note that appellants are claiming a particular structure (i.e., a guide rail for guiding photographic film and paper without adverse affect on said film and paper), not merely a composition of matter as the examiner seems to believe in the first quoted portion of the answer above. Thus, we consider the examiner's reliance on Titanium Metals Corp. v. Banner (answer, page 4) to be wholly inapposite. As for the examiner's proposed combination of Yoshida and Ghosh '282 or Chatterjee '332 or '913, we view the examiner's conclusion that it would have been merely an obvious matter of design choice for one of ordinary skill in the art to select the specific zirconium-based ceramic materials of the secondary references for use in the bearing guide rails (14, 15, 20 21) of Yoshida, to be rooted in speculation and conjecture, and based on improper hindsight afforded by first having read appellants' disclosure in the present application, or at the very least, to be based on an

improper "obvious to try" approach to patentability determinations. Of the thousands of ceramic materials available in the prior art, what would have led one of ordinary skill in the art to the specific zirconium-based ceramic material described in the applied prior art references as being for cutting tools (see, e.g., Ghosh '282, col. 2, lines 67-68)?

Moreover, given the particular problems in the photographic film guiding art confronted by appellants, we see no basis upon which to conclude that it would have been obvious to one of ordinary skill in the art to combine the applied prior art references relied upon by the examiner so as to result in a guide rail (claims 1-9) or guide rail insert (claims 10-18) suitable for "guiding photographic film and paper without adverse effect on said film and paper," as is specified in the claims before us on appeal. In this regard, we note that after considering the entirety of appellants' disclosure to gain an understanding of what the inventors actually invented and intended to encompass by the appealed claims, we are of the view that the preambular recitations in

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the appealed claims, do more than merely state a purpose or intended use of the claimed structure, but instead serve to provide a definition of the invention and give "life and meaning" to the claimed subject matter such that it must therefore be considered as a positive limitation in determining patentability. See Corning Glass Works v. Sumitomo Electric U.S.A. Inc., 868 F.2d 1251, 1257, 9 USPQ2d 1962, 1966 (Fed. Cir. 1989) and Diversitech Corp. v. Century Steps Inc., 850 F.2d 675, 7 USPQ2d 1315 (Fed. Cir. 1988).

Since we have concluded that the teachings and suggestions found in the references applied by the examiner would not have made the subject matter as a whole of claims 1 through 18 on appeal obvious to one of ordinary skill in the art at the time of appellants' invention, we must refuse to sustain the examiner's rejection of those claims under 35 U.S.C. § 103.

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In view of the foregoing, the examiner's decision
rejecting claims 1 through 18 of the present application under
35 U.S.C.
§ 103 is reversed.

REVERSED

HARRISON E. McCANDLISH)	
Senior Administrative Patent Judge)	
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)	
)	BOARD OF PATENT
)	
CHARLES E. FRANKFORT)	APPEALS AND
Administrative Patent Judge)	
)	INTERFERENCES
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)	
JOHN P. McQUADE)	
Administrative Patent Judge)	

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CEF/kis
J. JEFFREY HAWLEY
EASTMAN KODAK COMPANY
Patent Legal Staff
Rochester, NY 14650-2201